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NEWLIN, TIMOTHY R				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/541,051

**Applicant(s)**

NEWTON ET AL.

**Examiner**

Timothy R. Newlin

**Art Unit**

2424

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 8-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 8-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Response to Arguments*

Applicant's arguments have been fully considered but they are not persuasive.

First, Applicant argues that OPENTV does not teach signaling a category indicating that a data module is mandatory. However, OPENTV states that flags may be used to indicate particular data that *need* to be cached by the receiver [p. 5, ll. 25-26]. In the Examiner's opinion, this meets the recited language of a mandatory category. Applicant also appears to argue that even the claimed functionality is present in OPENTV, it is only in connection with playing a program as opposed to storing it. Examiner disagrees. OPENTV states that object properties (including flags to indicate necessary modules) can be used by the receiver in storing or replaying the data objects p. 5, ll. 26-27].

Next the Applicant asserts that OPENTV does not signal categories indicating that certain data objects are optional. Examiner notes that "optional" is an extremely broad term that does not imply and specific decision tree or protocol for choosing among optional data modules; it merely implies that a data module is not required to be saved nor is it prohibited from being saved. In that sense it is a negative limitation, covering data modules that are anything but required or prohibited. Accordingly, OPENTV, which allows a user to choose certain modules at will (e.g. "if a user wishes to record", "user initiates recording") meets the limitation. [p. 6, l. 38; p. 8, ll. 26-27].

Applicant also disputes the citation of OPENTV used to meet the recited category stating that a module is forbidden to record. "Forbidden" as recited is construed to mean any module that is prevented from being recorded. OPENTV describes a system whereby carousels comprising data object are given a temporal validity range. Outside that validity range, the data objects are unavailable or invalid [p. 8, ll. 5-7]. In other words, some data objects, as designated by a temporal validity range, may not be recorded, i.e. are forbidden to record. Thus the recited language is met by OPENTV.

The Applicant also explains some purported differences between OPENTV and the claimed invention. Applicant characterizes OPENTV as restricting availability of data modules to specific receivers, while the claimed invention categorizes data modules for the benefit of any receiver having a recording capability. While the object of the present invention is understood, it is not clear to the Examiner that the claimed difference would be patentably significant. In any event, the distinction between categorizing data modules for any receiver, and doing so for only selected receivers, is not reflected in the claim language itself and is therefore ineffective to distinguish over OPENTV.

For the reasons explained above, the rejections stand.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

1. Claims 1, 4-6, and 9-16 are rejected under 35 U.S.C. 102(a) as anticipated by OPENTV, WO 01/33852.
2. Regarding claim 1, OPENTV discloses a method and use of transmitting interactive television, whereby at least an interactive television application is transmitted inside application-modules in a broadcast stream that includes television content, said method comprising the step of  
signaling storage related information of said modules in a transmitted broadcast stream [p. 4, 32-35; p. 5, 26-27, pp. 6-7, lines 37-5]; and  
characterized in that said step of signaling storage related information comprises signaling of categories stating whether said modules are mandatory [if program is to be played immediately, the data objects are deemed *necessary*, p. 4, 31-32; flags are inserted identifying objects that *need* to be cached, p. 5, line 25-26], optional [programs can be stored at the option of the user, p. 6, 38, p. 8, 26-27; modules categorized as within a validity range are available, p. 8, 5-7], or forbidden [live data objects are not stored, p. 3, line 20; objects categorized as outside their validity range are unavailable for storage, p. 8, 5-7] to record.

3. Regarding claim 4, OPENTV discloses a method according wherein the step of signaling storage related information further comprises the step of signaling module identification information in said broadcast stream. **[p. 5, line 15; p. 7, 24-28].**

4. Regarding claim 5, OPENTV discloses a method whereby the step of signaling storage related information comprises signaling said storage related information and/or said module identification information in the Application Information Table **[file table, p. 3, 5-19]** and/or in the Download Information Indication message.

5. Regarding claims 6 and 12, OPENTV discloses a method whereby said module identification information is defined and included in the AIT and consists of two fields, the first field being an organisation\_id **[e.g., version number or carousel ID, p. 5, 13-16]** and the second field being an application\_id **[object identifiers are transmitted, p. 2, line 35]**, whereby said id values are used to identify identical applications **[version numbers are used by the receiver to identify identical versions, for example to filter incoming data objects, p. 5, 24-28].**

6. Regarding claim 9, OPENTV discloses a method whereby said signaling storage related information comprises signaling of properties of a module chosen from code and/or data **[p. 5, 29-30].**

7. Regarding claims 10 and 11, OPENTV discloses a method of receiving an interactive television broadcast stream for recording, whereby at least an interactive television application is comprised in the broadcast stream inside application-modules , said method comprising the steps of

extracting storage related information of said modules from said broadcast stream [p. 5, 12-18], and

recording of modules which are mandatory or optional to record, based on said storage related information **[flags indicate data objects that need to be recorded, p. 5, 24-28];**

characterized in that said storage related information comprises categories stating whether said modules are mandatory **[if program is to be played immediately, the data objects are deemed necessary, p. 4, 31-32; flags are inserted identifying objects that need to be cached, p. 5, line 25-26]**, optional **[programs can be stored at the option of the user, p. 6, 38, p. 8, 26-27; modules categorized as within a validity range are available, p. 8, 5-7]**, or forbidden **[live data objects are not stored, p. 3, line 20; objects categorized as outside their validity range are unavailable for storage, p. 8, 5-7]** to record.

8. Regarding claim 13, OPENTV discloses a method whereby said interactive television is MHP, OpenTV or DASE **[Summary section describes OPEN protocol. pp. 2-3].**

9. With respect to claim 14, OPENTV discloses an apparatus for recording and/or playing back interactive television, said apparatus being adapted to record and/or playback interactive television to and from a storage medium respectively, said apparatus being adapted to receive interactive television from a broadcast stream, said apparatus comprising

means for extracting storage related information of said modules transmitted inside said broadcast stream **[p. 5, 12-18]**, and

means for recording of modules **[receiving station 18 and mass storage device 16, Fig. 1]**.

characterized in that said storage related information comprises categories stating whether said modules are mandatory **[if program is to be played immediately, the data objects are deemed *necessary*, p. 4, 31-32; flags are inserted identifying objects that *need* to be cached, p. 5, line 25-26]**, optional **[programs can be stored at the option of the user, p. 6, 38, p. 8, 26-27; modules categorized as within a validity range are available, p. 8, 5-7]**, or forbidden **[live data objects are not stored, p. 3, line 20; objects categorized as outside their validity range are unavailable for storage, p. 8, 5-7]** to record, and said means for recording being adapted to record only modules for which said storage related information allows recording.

10. Regarding claim 15, OPENTV discloses an apparatus whereby said storage related information comprises module identification information for modules, and whereby said apparatus further comprises means for preventing recording of more than



one application module with identical module identification information on a storage medium in said apparatus **[version numbers are used by the receiver to identify identical versions, for example to filter incoming data objects, p. 5, 24-28]**.

11. Regarding claim 16, OPENTV discloses a computer-readable medium having embodied thereon a computer program for processing by a computer, the computer program comprising a code segment for signaling storage related information of modules in an interactive television broadcast stream, whereby at least an interactive television application is transmitted inside application-modules in a broadcast stream **[broadcast station 12 and application execution engine perform the method disclosed in OPENTV, see Summary, pp.2-3; p. 4, 11-35];**

characterized in that said storage related information comprises categories stating whether said modules are mandatory **[if program is to be played immediately, the data objects are deemed *necessary*, p. 4, 31-32; flags are inserted identifying objects that *need* to be cached, p. 5, line 25-26]**, optional **[programs can be stored at the option of the user, p. 6, 38, p. 8, 26-27; modules categorized as within a validity range are available, p. 8, 5-7]**, or forbidden **[live data objects are not stored, p. 3, line 20; objects categorized as outside their validity range are unavailable for storage, p. 8, 5-7]** to record.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 2, 3, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over OPENTV as cited above, in view of Metz et al., US 5,678,539.

13. Regarding claim 2, OPENTV does not disclose using DSMCC modules to transmit application data. Metz teaches this method at **col. 10, 5-12**. One of ordinary skill would have been motivated to format the data modules disclosed in OPENTV for transmission via DSMCC protocol, in order to provide a standard data format usable by a wide range of receivers. Metz articulates the need for a standard interface protocol [**col. 4, 53-64**]. Using DSMCC provides a standard protocol that can be used across different receiver platforms.

14. Regarding claim 3, OPENTV discloses a method wherein said at least one application object comprises at least one application file object and at least one application directory object, said application file object comprising at least one application file and said at least one application directory object comprising storage directory information on respective application file [**p. 3, 5-6; p. 5, 14-16**].

15. Regarding claim 8, OPENTV discloses a system that generates groups of modules with similar storage related information in an object carousel for broadcasting **[carousels are groups of data objects that are transmitted together, with corresponding version numbers and carousel references, pp. 7-8, lines 26-2; p. 8, lines 22-28]**. As discussed above, Metz teaches the use of DSMCC protocol.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Timothy R. Newlin whose telephone number is (571) 270-3015. The examiner can normally be reached on M-F, 8-5 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher Kelley/  
Supervisory Patent Examiner, Art  
Unit 2424

TRN